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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,348	12/08/2000	Eric Schneider		2277
24226	7590	11/30/2004		EXAMINER MAURO JR, THOMAS J
ERIC SCHNEIDER 13944 CEDAR ROAD # 258 UNIVERSITY HEIGHTS, OH 44118			ART UNIT 2143	PAPER NUMBER

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/733,348	SCHNEIDER, ERIC	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas J. Mauro Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 01 September 2004.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 21-29 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 30-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 September 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This action is responsive to the amendment filed on September 1, 2004. Claims 1-20 have been cancelled. Claims 21-40 have been newly added and are presented for examination. A formal action on the merits of claims 21-40 follows.

*Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 21-29, drawn to marking postal mail, classified in class 209, subclass 584.
- II. Claims 30-40, drawn to undeliverable e-mail, classified in class 709, subclass 206.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are used in two different systems, one being postal and the other electronic mail thereby having different modes of operations and functions.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Newly submitted claims 21-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 21-29 are directed towards actual articles of mail in the postal system, whereas the original claims were directed towards undeliverable electronic mail. Therefore, due to the amendment submitted, a restriction is now proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-29 (Group I) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 30 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 30 and 40, applicant recites "at least one of a second recipient email address and one or more web address." It is unclear and therefore indefinite as to whether the applicant intends it to mean that (1) the second message contains at least one of an email address or web address or (2) at least one of one or more email addresses and one or more web addresses. Proper correction is required to remove the ambiguity. For the purposes of this action, Examiner has interpreted claims 30 and 40 in light of meaning (2) above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 30-35 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. (U.S. 6,438,583) and Weyer et al. (U.S. 6,671,714).

Regarding claim 30, McDowell teaches a delivery method comprising:  
determining that a first message from a sender having a sender email address can not be delivered to a recipient having a first recipient email address [McDowell -- Figure 14A and Col.

**12 lines 60-62 – Old ISP, upon receiving email message, determines that recipient is no longer present];**

generating a second message having information that can assist said sender in attempting to locate said recipient wherein said information includes at least a second recipient email address, wherein said second recipient email address includes said first recipient email address

**[McDowell Figure 14A and Col. 6 lines 1-10 and 30-43 – Bounce message, i.e. second message, is sent back to sender and prompts the user with information to help locate and deliver to message to the recipient. The sender is presented with a graphical button which can be clicked to send another message to a second recipient email address (underlying email link via graphical button) which includes the first email address (1<sup>st</sup> address – user@oldisp.com; 2<sup>nd</sup> address – user@oldisp.com.re-route.com)]; and**

delivering said second message to said sender email address **[McDowell -- Figure 14A and Col. 12 lines 60-62 – Undeliverable message is bounced back to sender].**

McDowell fails to explicitly teach providing information including a web address corresponding to a recipient webpage.

Weyer, however, discloses a system for querying and online directory service which returns the user contact information for a person, including an email address and personal webpage of the queried user, to the requesting user **[Weyer -- Col. 1 lines 46-67 – Col. 2 lines 1-17, Col. 3 lines 51-57, Col. 5 lines 52-63 and Col. 11 lines 52-63].**

Both McDowell and Weyer are concerned with locating an unknown or erroneous e-mail account/web address by querying another server for information regarding a user.

Therefore, it would have been obvious to a person of ordinary skill in the art to incorporate the queried web address of the recipient, as taught by Weyer into the invention of McDowell, in order to provide the requesting user with additional information about a recipient which can help them locate, contact and find out more information about them which is less tedious and more successful than other means **[Weyer -- Col. 1 lines 30-34]**.

Regarding claim 31, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein said second message includes at least a portion of said first message **[McDowell -- Col. 6 lines 31-33 and Col. 12 lines 49-62 – Bounced messages, i.e. second message, implicitly contains the first message in it along with the error or reasons why delivery failed, i.e. user unknown]**.

Regarding claim 32, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein said determining that said first message can not be delivered includes determining that said first recipient e-mail address no longer exists **[McDowell -- Figure 14A and Col. 12 lines 59-62 – Message is routed to old ISP and determined that the recipient account is no longer present, i.e. no longer exists]**.

Regarding claim 33, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein said information that can assist said sender in attempting to locate said recipient is in a form of a hyperlink reference **[McDowell -- Col. 6 lines 35-47 and Col. 12 lines 53-58 – Bounced mail message contains a hyperlink reference**

**to another service to assist the user in finding the recipient. Reference is embedded in a graphical button presented to the user].**

Regarding claim 34, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein generating said second email address includes adding one or more domains to said first recipient email address [**McDowell -- Col. 6 lines 1-10 – Re-route.com domain is added, i.e. appended, to the first email address, i.e. user@oldisp.com].**

Regarding claim 35, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 34 above, including wherein said at least one domain of said one or more domains is a top level domain [**McDowell -- Col. 6 lines 1-10 – Re-Route.com which contains the commercial TLD is added].**

Regarding claim 37, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein said web address includes a portion of said first recipient email address [**McDowell -- Col. 6 lines 1-10 and Weyer -- Col. 11 lines 64-67 – Col. 12 lines 1-12 – E-mail address is in the form user@oldisp.com and web address is in the form user.everymd.com, thus both addresses incorporate the user's user name].**

Regarding claim 38, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 37 above, including wherein said first recipient email address is of a

form username@domainname [McDowell Col. 6 lines 1-10 – Email address of user is user@oldisp.com] and said web address is of the form scheme://username.domainname [Weyer Col. 11 lines 64-67 and Col. 12 lines 1-12 – Web address of user is jhsmith.everymd.com, i.e. scheme://user.domainname].

Regarding claim 39, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including an ability for said sender to select the second recipient email address and/or web address [McDowell -- Col. 6 lines 35-43 – User selects message to be routed to the second recipient email address by clicking, i.e. selecting, a graphical button containing the embedded second address].

Regarding claim 40, McDowell teaches a computer program product comprising computer readable program code stored on a computer readable medium. The remaining limitations in claim 40 are similar to the limitations in claim 30 above. Therefore, they are rejected under the same rationale.

11. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. (U.S. 6,438,583) and Weyer et al. (U.S. 6,671,714), as applied to claim 30 above, in view of Agrapharam et al. (U.S. 5,987,508).

Regarding claim 36, McDowell-Weyer teach the invention substantially as claimed, as aforementioned in claim 30 above, including wherein said first recipient address is of a form user@host.gTLD [McDowell -- Col. 6 lines 1-4].

McDowell-\*\*\*\* fail to explicitly teach said second form of user@host.gTLD.ccTLD.

McDowell, however, does teach modifying a first recipient address and appending TLD information to the first address [McDowell -- Col. 6 lines 1-10].

In addition, Agraharam discloses that email address can have country codes (cc) added to a mail message to direct email messages to servers located outside of the United States without having the user explicitly know which CC to add [Agraharam -- Col. 3 lines 10-23 and Col. 5 lines 8-23].

Therefore, if McDowell can append information such as TLD's to a first email address to create a second recipient email address, it would have been obvious to append the country code designations, as taught by Agraharam into the invention of McDowell-Weyer in order to allow re-route servers to locate and route mail to users located in various countries throughout the world, thereby providing the users with a convenient and automated way to help locate users of wrong email addresses.

### *Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nielsen (U.S. 6,405,243) discloses a method for updating email addresses which have been changed.
- Gabber et al. (U.S. 6,591,291) discloses a system for altering and appending information, including a TLD, to an email address.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 571-272-3917. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM

November 22, 2004



**BUNJOB JAROENCHONWANT**  
**PRIMARY EXAMINER**